

REMARKS

Claims 5 to 7, 9, and 11 to 23 are pending and under examination in this application.

Claim Rejections – 35 U.S.C. § 102

The Examiner has rejected claims 5 to 7, 11 to 13, 15, 16, 18, and 20 to 22 under 35 U.S.C. § 102(b) as being anticipated by Hawkins et al. (4,790,812). Applicants respectfully traverse this rejection.

Claim 5 is an independent claim directed to a method of protecting a patient from embolization during a percutaneous procedure on a vessel and includes the step of “expanding the vessel at the treatment site”. Hawkins neither discloses nor teaches this step. Rather, Hawkins treats the vessel by fragmenting the atheroma forming the stenosis by advancing a drilling device over the control wire of a parachute basket. The drilling device has a tapered drill head which rotates at a high speed to generate atheroma fragments. The fragments are urged upstream into a lumen of a catheter by suction provided by a suction device. As the fragments are urged inside the lumen of the catheter their size is further reduced by a rotating cutting tip housed entirely within the catheter. (Hawkins, Col. 5, lines 8 to 25).

Clearly Hawkins does not explicitly or implicitly disclose or suggest that the treatment of the vessel include expanding the vessel at the treatment site. When the drilling device is advanced into contact with the stenosis the drilling head is rotating at a high speed and Hawkins discloses that the intended result is to fragment the atheroma which forms the stenosis. Nowhere in the specification or drawings does Hawkins disclose or suggest that the treatment also include

expanding the vessel at the treatment site. Further, use of the device disclosed by Hawkins does not inherently result in expansion of the vessel. To establish inherency it is not sufficient that a characteristic may occur or be present in the prior art. Rather, the characteristic must necessarily be present in the prior art. (see, MPEP 2112). Even if, for the sake of argument, it might be possible to use the device disclosed in Hawkins in a manner which would result in expansion of the vessel there is no reason for a person of skill in the art to believe that expansion of the vessel would necessarily result from use of that device. Therefore, Applicants submit that claim 5, and claims 6, 7, 9, 11, 15, 16, and 18 which depend from claim 5, are not anticipated by Hawkins.

Claim 12 is an independent claim directed to a percutaneous system for treating a vessel at a region of stenosis and filtering emboli. The system includes a guidewire having an expandable filter associated with a distal region of the guidewire. The system further includes a catheter having a lumen which slidably receives the guidewire. The catheter includes a treatment device with a “radially expandable member”. Hawkins does not disclose a system having these features. Specifically, Hawkins does not disclose a catheter which is slidable over a guidewire and which has a treatment device with a radially expandable member. Hawkins discloses a parachute basket 11 having a control wire 26. Hawkins further discloses a catheter having a treatment device in the form of drilling device 13 which is slidable over the control wire 26. Drilling device 13 has a tapered drill head 36. However, tapered drill head 36 is not radially expandable. Further, no other component of the treatment device disclosed in Hawkins appears to be radially expandable. Therefore, Applicants submit that claim 12, and claims 13 and 20 to 22 which depend from claim 12, are not anticipated by Hawkins.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 14, and 16 to 23 under 35 U.S.C. § 103(a) as being obvious over Hawkins (4,790,812) in view of Simon (4,425,908). Applicants respectfully traverse this rejection.

As set forth above claims 5 and 12, the only independent claims, distinguish over Hawkins for the reasons stated. Simon does not correct the deficiencies of Hawkins in connection with claims 5 and 12. Claims 14 and 16 to 23 depend from either claim 5 or claim 12 and add further limitations. Therefore, claims 14 and 16 to 23 are allowable for at least the same reasons as claims 5 and 12.

Based on the foregoing Applicants respectfully request that the rejections of the pending claims be withdrawn.

If any additional fees are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

Date: 5/19/08

By 

Customer No. 009561

Terry L. Wiles (29,989)

Patrick J. O'Connell (33,984)

POPOVICH, WILES & O'CONNELL, P.A.

650 Third Avenue South, Suite 600

Minneapolis, MN 55402-1911

Telephone: (612) 334-8989

Attorneys for Applicants